

Docket No.: SGU-0068

10 Rec'd PCT/MC

MAY 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Confirmation No.: 9105

Andrew Peter KNIGHTS et al.

Group Art Unit: Unknown

Serial No.: 10/500,318

Examiner: Unknown

Filed: June 28, 2004

Customer No.: 34610

For: AN IN-LINE LIGHT SENSOR

**PETITION TO ACCEPT DECLARATION OF AN
APPLICATION WITHOUT THE SIGNATURE OF A
REFUSING INVENTOR UNDER 37 C.F.R. § 1.47 AND MPEP § 409.03(a)**

U.S. Patent and Trademark Office
Customer Window - **PETITION**
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

The undersigned requests the Commissioner to accept the above-identified application with a Declaration having only the signatures of Andrew P. Knights, Dominic J. Brady, Andrew A. House and George F. Hopper, co-inventors, and without the signature of the refusing inventor, Adrian P. Vonsovici.

In support of the Petition, filed herewith are:

1) A Declaration by each of the available inventors Andrew P. Knights, Dominic J. Brady, Andrew A. House and George F. Hopper.

2) The required Petition Fee of \$130.00.

3) A Statement of Facts by Dr. Haydn Jones, who is the person who presented the application papers to Mr. Vonsovici, and which states the relevant facts.

4) The last known address of the non-signing joint inventor, Mr. Adrian P. Vonsovici is 59 Runnymede, Merton Abbey, London SW19 2PG, United Kingdom.

Also attached hereto is:

- A. Reply to Notification of Missing Requirements Under 35 U.S.C. § 371 in the United States Designated/Elected Office;
- B. Copy of form PCT/DO/EO/905 (Notification of Missing Requirements);
- C. Request for Extension of Time; and
- D. The required extension fee of \$450.00.

BACKGROUND OF FACTS

1) This application, U.S. Patent Application No. 10/500,318, is a § 371 National Stage of International Application No. PCT/GB02/05930 with an International filing date of December 27, 2002. The application entered National Stage on June 28, 2004.

2) The application was filed without the required Declaration by Andrew P. Knights, Dominic J. Brady, Andrew A. House, George F. Hopper, and Adrian P. Vonsovici. Consequently, a Notification of Missing Requirements under 35 U.S.C. § 371 was issued on January 11, 2005.

3) Andrew P. Knights, Dominic J. Brady, Andrew A. House and George F. Hopper have signed the Declaration, which is attached. However, Adrian P. Vonsovici has refused to sign the Declaration.

4) In late January of 2005, the application papers were presented to Mr. Vonsovici with the Declaration for his signature. However, Mr. Vonsovici refused to sign the attached

Declaration. Attached hereto is a Statement of Facts by Dr. Haydn Jones who had the papers presented to Mr. Vonsovici for signing.

5) Consequently, Mr. Vonsovici, having been presented with the application papers, has refused to join in the application. Therefore, Mr. Vonsovici is an unavailable inventor.

6) The signature block of the unavailable inventor, Mr. Vonsovici, is left blank in the attached Declaration by the inventors. Under MPEP § 409.03(a)(A), such may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor, unless otherwise indicated. Consequently, a separate Declaration by all of the joining inventors for the non-signing joint inventor need not be separately required, and the undersigned requests the attached Declarations be treated as such.

CONCLUSION

In view of the above and as supported by the attached papers, granting of this Petition is respectfully requested.

If the Patent Office personnel have any questions regarding this petition, they are invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
FLESHNER & KIM, LLP



John C. Eisenhart
Registration No. 38,128
Seth S. Kim
Registration No. 54,577

Attachments:

Declaration by Andrew P. Knights, Dominic J. Brady,
Andrew A. House and George F. Hopper
Statement of Facts

P.O. Box 221200
Chantilly, VA 20153-1200
703 502-9440 DYK/JCE/SSK:knv
Date: MAY 9, 2005

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STATEMENT OF FACTS

U.S. Patent and Trademark Office
Customer Window - PETITION
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

1) I, Dr. Haydn Jones, am the Director of Intellectual Property at Bookham Technology plc (hereinafter "Bookham") having an address of Caswell, Towcester, Northamptonshire NN12 8EQ, United Kingdom (formerly of 90 Milton Park, Abingdon, Oxfordshire OX14 4RY, United Kingdom).

2) Mr. Adrian P. Vonsovici was an employee of Bookham when he co-invented the subject matter of the above identified application. Subsequently, Mr. Vonsovici left the employ of Bookham.

3) In January 2005 I directed that copies of the application papers and a Declaration for the above identified U.S. National Stage Application for the International Application No. PCT/GB02/05930 be forwarded to Mr. Adrian P. Vonsovici for his review and signature. Our correspondence with Mr Vonsovici is dated 31 January 2005 and 3 February 2005.

4) In response, Mr. Vonsovici forwarded the attached e-mail letter dated February 8,

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U.S. Application No. 10/500,318

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2005 refusing to sign the application. Subsequently, I forwarded the attached e-mail on February 24, 2005 addressing the concerns of Mr. Vonsovici and again requesting his signature on the Declaration.

4) Mr. Vonsovici has yet to return the signed Declaration and has not indicated any willingness to join this application.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, (35 U.S.C. § 1001) of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent resulting therefrom, declares herewith that all statements made on my own knowledge are true and that all statements made on information and belief are believed to be true.

Date:

4 May 2005Haydn Jones

Dr. Haydn Jones

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Kate Ball

From: Haydn Jones
Sent: 24 February 2005 17:40
To: adrianvonsovici@onetel.com
Cc: Kate Ball
Subject: PCT/GB02/05930

Dear Adrian,

Many thanks for your queries in this matter. These things can be complicated but I shall explain as best I can.

Bookham has decided to try to retain a patent interest in the area of silicon in-line photodetectors but on a very tight budget. The team at Milton generated at least three patent applications and one further disclosure related to this subject. These are on our records as having inventors:

- 1) Andrew Knights
- 2) Andrew Knights, Adrian Vonsovici and Dominic Brady
- 3) Andrew House
- 4) Fred Hopper

Incidentally, the people named are inventors, not authors. The patent specifications are written by patent attorneys. The order in which the inventors appear on the documents has no legal or other significance.

In order to economise, we have bundled all four inventions together for the present, so all of the above names appear on the document you received. When the examiner has done his work (and if we decide to continue with the application) the inventors' names will be ascribed by proper process to the allowed claims and then the patent inventor list will be amended accordingly. The document you have been asked to sign merely confirms that you are one of the inventors of some if not all of the matter in the document and that you are willing for your rights in these claims to be assigned to Bookham Technology plc.

I can assure you that the process that I have described here is not driven by "upper management" but by proper process advised by qualified patent attorneys.

If you have relevant prior art documents (you mention your PhD thesis and I think we have not seen this), we would be glad if you would send us reference to them and we can ensure that the patent examiner is made aware of them. In fact, under US law, everyone involved including inventors has an obligation to let the US Patent and Trademark Office know of any relevant prior art that comes to their notice. Any other comments that you might have would, of course, be welcome but you are not obliged to give them and, unfortunately, we are not in a position to ask you to do any consultancy for us at the present.

I hope that this clarifies the matter and that you will feel able to sign the document and return it to me.

With kind regards.

Haydn.

Haydn Jones
Director Intellectual Property
Bookham
Caswell
Towcester
NN12 8EQ

From: ADRIANVONSOVICI [mailto:adrianvonsovici@onetel.com]
Sent: 08 February 2005 13:18
To: Kate Ball
Cc: Haydn Jones
Subject: PCT/GB02/05930

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08/03/2005

Dear Mrs Ball,

You have send me some documents regarding one of the Bookham patent applications (PCT/GB02/05930).

I was very suprised that my original invention of an in-line light sensor was filed having "attached" authors that have nothing to do with the invention. The consequence of that could be the invalidation of the invention.

The only authors worth to be mentioned as inventors are Adrian VONSOVICI and Andrew KNIGHTS (in this particular order). In a discussion with the patent agent me and Andy Knights we have accepted to have Dominic BRADY as a co-inventor for some add-ons but in the end these are no more present in the final invention. Therefore he is not an inventor for the in-line light sensor.

The other two persons, Frederic HOPPER and Andrew HOUSE are not inventors being just involved with some experimental activities regarding the demonstrations of some of the concepts mentioned in the application for a patent. I can support this with documents that were well known especially by Fred HOPPER regarding my proposal for monitoring devices to be used on an ASOC platform. The documents were exchanged between me as a responsible of the Advanced Silicon Devices (within Advanced Research group) and Fred Hopper as a responsible of the Active Devices group. The ideas in the application for the in-line sensor had nothing to do with the activity of Andrew HOUSE or Fred HOPPER as inventors. Moreover the embodiements that Dominic BRADY proposed are no more present in the application. Consequently the three people mentioned are not inventors and the entire application could be jeopardised by these misfortunate errors.

There are many other claims that could not stand a proper evaluation especially the wavelength selective detectors that are mentioned in public domain in embodiements similar to the ones sustained by Bookham (including my PhD thesis!). But I could not follow properly these details as the application was filed improperly after my leave from Bookham.

Please do the required modifications and send me a proper document as I do not want to associate myself with an application where inventors are added following some internal dispositions from the upper management. If you need to give you professional advise about the issues in the patent application I would suggest some consultancy fees for the time I will spend on the matter. They are in line with the fees in the photonics profession.

Best regards,
Adrian VONSOVICI

DR. ADRIAN VONSOVICI
Managing Director,

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08/03/2005

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